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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/732,350

12/07/2000

Allan Svendsen

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NOVOZYMES NORTH AMERICA, INC.  
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NEW YORK, NY 10110

EXAMINER

PAK, YONG D

ART UNIT

PAPER NUMBER

1652

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

01/05/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

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<b>Office Action Summary</b>	<b>Application No.</b>		<b>Applicant(s)</b>	
	09/732,350		SVENDSEN ET AL.	
	<b>Examiner</b>		<b>Art Unit</b>	
	Yong D. Pak		1652	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 15 March 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 64-95 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 64-95 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

This application is a divisional of 09/396,260, issued as US Patent 6,184,015, which is a divisional of 09/032,315, issued as US Patent 5,985,818.

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on March 15, 2006 has been entered.

Claims 64-95 are pending and are under consideration.

The indicated allowability of claims 64-95 is withdrawn in view of the newly discovered reference(s) to US Patent No. 6,218,170, US Patent No. 6,060,442, US Patent No. 5,770,419 and US Patent No. 6,277,611. Rejections based on the newly cited reference(s) follow.

### ***Claim Objection***

Claim 64 is objected to in the recitation of "G511F..." without the recitation of the "(k)". In order to improve clarity, it is suggested that, for example, the term be amended as follows: "(k) G511F".

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 64-95 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-16 of U. S. Patent No. 6,218,170 and claims 1-14 of US Patent 6,060,442. Although the conflicting claims are not identical, they are not patentably distinct from each other because they are claiming common subject matter, as follows: Claims 64-95 of the instant application and claims 1-16 of U. S. Patent No. 6,218,170 and claims 1-14 of US Patent 6,060,442 are directed to a mutant of lacasse comprising an amino acid substitution(s) at positions 106, 108 or 109 and one or more amino acid substitution at residues 185-194, 234-236, 269 and 293-294. The lacasse of SEQ ID NO:10 of the instant application is 100% identical to the lacasse of SEQ ID NO:1 of the reference patents (See Sequence

Alignment – US Patent 6,218,170 and US Patent 6,060,442). Therefore, the conflicting claims are not patentably distinct from each other.

Alternatively, claims 64-95 of the instant application cannot be considered patentably distinct over the claims of the reference patents because it would have been obvious to one having ordinary skill in the art to modify claims 1-16 or 1-14 US Patent 6,218,170 and US Patent 6,060,442, respectively, by selecting a specifically disclosed embodiment that supports those claimed, i.e. a mutant lacasse comprising substitutions at positions 93, 95, 428, 433, 500, 506, 510 and/or 514. One of ordinary skill in the art would have been motivated to do this because the embodiments claimed in the instant claims are disclosed as being a preferred embodiment within the reference patents (Columns 1-2). Therefore, the conflicting claims are not patentably distinct from each other.

Claims 64, 71 and 75 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-18 of U. S. Patent No. 5,770,419. Although the conflicting claims are not identical, they are not patentably distinct from each other because they are claiming common subject matter, as follows: Claims 64-95 of the instant application and claims 1-18 of U. S. Patent No. 5,770,419 are directed to a mutant of lacasse comprising an amino acid substitution(s) at positions 433 and/or 511. The lacasse of SEQ ID NO:10 of the instant application is 100% identical to the lacasse of SEQ ID NO:27 of the reference patent (See Sequence

Alignment – US Patent 5,770,419). Therefore, the conflicting claims are not patentably distinct from each other.

Claims 64 and 71 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 9 of US Patent 6,277,611. Although the conflicting claims are not identical, they are not patentably distinct from each other because they are claiming common subject matter, as follows: Claims 64-95 of the instant application and claim 9 of U. S. Patent No. 6,277,611 are directed to a mutant of lacasse comprising an amino acid substitution at position 433. The lacasse of SEQ ID NO:10 of the instant application is 100% identical to the lacasse of SEQ ID NO:10 of the reference patents (See Sequence Alignment – US Patent 6,277,611. Therefore, the conflicting claims are not patentably distinct from each other.

None of the claims are allowable.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yong Pak whose telephone number is 571-272-0935. The examiner can normally be reached 6:30 A.M. to 5:00 P.M. Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathapu Achutamurthy can be reached on 571-272-0928. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-1600.


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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free).



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